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**UTILITY  
PATENT APPLICATION  
TRANSMITTAL**

(Only for new nonprovisional applications under 37 CFR 1.53(b))

**Attorney Docket No.** 1256-00922  
**First Inventor** Hector F. DeLuca  
**Title** Use of 2Alpha-M thyl-19-Nor-20(S)-1Alpha,25-Dihydroxyvitamin D3 to Increase Bone Strength  
**Express Mail Label No.** EV342894585US

22388 U.S. P. 6  
 10/673618  
 09/29/03

**APPLICATION ELEMENTS**

See MPEP chapter 600 concerning utility patent application contents.

1. ☒ Fee Transmittal Form (e.g., PTO/SB/17)  
 (Submit an original and a duplicate for fee processing)
2. ☒ Applicant claims small entity status.  
 See 37 CFR 1.27.
3. ☒ Specification [Total Pages 20]  
 (preferred arrangement set forth below)
- Descriptive title of the invention
  - Cross Reference to Related Applications
  - Statement Regarding Fed sponsored R & D
  - Reference to sequence listing, a table, or a computer program listing appendix
  - Background of the Invention
  - Brief Summary of the Invention
  - Brief Description of the Drawings (if filed)
  - Detailed Description
  - Claim(s)
  - Abstract of the Disclosure
4. ☒ Drawing(s) (35 U.S.C. 113) [Total Sheets 3]
5. ☐ Oath or Declaration [Total Pages 3]
- a. ☐ Newly executed (original or copy)  
 Copy from a prior application (37 CFR 1.63 (d))  
 (for continuation/divisional with Box 18 completed)
- b. ☒ **DELETION OF INVENTOR(S)**  
 Signed statement attached deleting inventor(s) named in the prior application, see 37 CFR 1.63(d)(2) and 1.33(b).
6. ☐ Application Data Sheet. See 37 CFR 1.76

**ADDRESS TO:** Assistant Commissioner for Patents  
 Box Patent Application  
 Washington, DC 20231

7. ☐ CD-ROM or CD-R in duplicate, large table or Computer Program (Appendix)
8. Nucleotide and/or Amino Acid Sequence Submission (if applicable, all necessary)
- a. ☐ Computer Readable Form (CRF)
- b. Specification Sequence Listing on:
- i. ☐ CD-ROM or CD-R (2 copies); or
- ii. ☐ paper
- c. ☐ Statements verifying identity of above copies

**ACCOMPANYING APPLICATION PARTS**

9. ☐ Assignment Papers (cover sheet & document(s))
10. ☐ 37 CFR 3.73(b) Statement of Attorney (when there is an assignee) ☐ Power of Attorney
11. ☐ English Translation Document (if applicable)
12. ☐ Information Disclosure Statement (IDS)/PTO-1449 ☐ Copies of IDS Citations
13. ☐ Preliminary Amendment
14. ☒ Return Receipt Postcard (MPEP 503) (Should be specifically itemized)
15. ☐ Certified Copy of Priority Document(s) (if foreign priority is claimed)
16. ☐ Nonpublication Request under 35 U.S.C. 122 (b)(2)(B)(i). Applicant must attach form PTO/SB/35 or its equivalent.
17. ☐ Other: \_\_\_\_\_

18. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in a preliminary amendment, or in an Application Data Sheet under 37 CFR 1.76:

☐ Continuation ☒ Divisional ☐ Continuation-in-part (CIP) of prior application No.: 10,045,941

Prior application information: Examiner: San Ming R. Hui Group Art Unit: 1617

For CONTINUATION OR DIVISIONAL APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

**19. CORRESPONDENCE ADDRESS**

<input checked="" type="checkbox"/> Customer Number or Bar Code Label	26753 (Insert Customer No. or Attach bar code label here)		or <input type="checkbox"/> Correspondence address below	
Name: Thomas M. Wozny				
Address: Andrus, Sceales, Starke & Sawall, LLP				
100 East Wisconsin Avenue, Suite 1100				
City	Milwaukee	State	WI	Zip Code
				53202-4178
Country	USA	Telephone	(414) 271-7590	Fax
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Name (Print/Type)	Thomas M. Wozny	Registration No. (Attorney/Agent)	28,922
Signature	<i>Thomas M. Wozny</i>	Date	09/29/2003

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# FEE TRANSMITTAL for FY 2003

Effective 01/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ ) 375.00

## Complete if Known

Application Number  
Filing Date  
First Named Inventor **Hector F. DeLuca**  
Examiner Name  
Art Unit  
Attorney Docket No. **1256-00922**

## METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☐ Deposit Account:

Deposit Account Number **01.2000**  
Deposit Account Name **Andrus, Scales, Starke & Sawall, LLP**

The Commissioner is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Credit any overpayments  
☐ Charge any additional fee(s) during the pendency of this application  
☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 750	2001 375	Utility filing fee	\$375
1002 330	2002 165	Design filing fee	
1003 520	2003 260	Plant filing fee	
1004 750	2004 375	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	
SUBTOTAL (1)			(\$ ) 375.00

### 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims **5** -20\*\* = **0** X **Fee from below** = **Fee Paid** **-0-**  
Independent Claims **1** -3\*\* = **0** X **Fee from below** = **Fee Paid** **-0-**  
Multiple Dependent **Fee from below** = **Fee Paid** **-0-**

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 84	2201 42	Independent claims in excess of 3
1203 280	2203 140	Multiple dependent claim, if not paid
1204 84	2204 42	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$ ) 0.00

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for <i>ex parte</i> reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 410	2252 205	Extension for reply within second month	
1253 930	2253 465	Extension for reply within third month	
1254 1,450	2254 725	Extension for reply within fourth month	
1255 1,970	2255 985	Extension for reply within fifth month	
1401 320	2401 160	Notice of Appeal	
1402 320	2402 160	Filing a brief in support of an appeal	
1403 280	2403 140	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,300	2453 650	Petition to revive - unintentional	
1501 1,300	2501 650	Utility issue fee (or reissue)	
1502 470	2502 235	Design issue fee	
1503 630	2503 315	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 750	2809 375	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 750	2810 375	For each additional invention to be examined (37 CFR 1.129(b))	
1801 750	2801 375	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ ) 0.00

## SUBMITTED BY

Name (Print/Type) **Thomas M. Wozny**  
Signature *Thomas M. Wozny*

Registration No. **28,922**  
(Attorney/Agent)

(Complete if applicable)

Telephone **414-271-7590**

Date **09/29/2003**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Divisional Application of:

Hector F. DeLuca  
Connie M. Smith

**Parent Application Data:**

Application No.: 10/045,941

Filed: October 19, 2001

Group Art Unit: 1617

Examiner: San Ming R. Hui

USE OF 2 $\alpha$ -METHYL-19-NOR-20(S)-  
1 $\alpha$ , 25-DIHYDROXYVITAMIN D<sub>3</sub> TO  
INCREASE BONE STRENGTH

CERTIFICATE OF EXPRESS MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as EXPRESS MAIL in an envelope addressed to: Commissioner of Patents Alexandria, VA 22313-1450 on this 29th day of September, 2003. The Express Mail Label is EV342894585US.

 September 29, 2003  
Dorothy A. Hauser Date

NOTIFICATION OF THE FILING OF A DIVISIONAL APPLICATION

Mail Stop: Divisional Application  
Commissioner of Patents  
Alexandria, VA 22313-1450

Sir:

This is a request for filing a divisional application, of pending prior Application No. 10/045,941, filed October 19, 2001 of Hector F. DeLuca and Connie M. Smith for "Use of 2 $\alpha$ -Methyl-19-Nor-20(S)-1 $\alpha$ ,25-Dihydroxyvitamin D<sub>3</sub> to Increase Bone Strength".

1. I hereby verify that the attached papers are a true copy of what is shown in my records to be the above-identified parent application, including the Oath or Declaration originally filed. No amendments referred to in the Declaration introduced new matter in the application.

2. The papers of the parent application, as filed, which are attached are as follows:

20 Pages of specification  
5 Claims  
1 Page of abstract  
3 Sheets of drawings  
3 Pages of declaration and power of attorney

Applicants: Hector F. DeLuca et al  
Attorney Docket No.: 1256-00922

3. The filing fee is computed as indicated in the attached Fee Transmittal PTO Form SB/17.

4. A check in the amount of \$375.00 accompanies this application to cover the filing fee pursuant to 37 C.F.R. §1.16. Kindly charge any additional patent filing or processing fees in this divisional application under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 01.2000. An additional copy of this notification is enclosed.

5. The prior application is assigned of record to Wisconsin Alumni Research Foundation of Madison, Wisconsin, and the Assignment is effective to assign the present continuation application to Wisconsin Alumni Research Foundation. The assignment was recorded on October 6, 2000, at Reel 11234, Frame Nos. 644-648. A copy of the Notice of Recordation of Assignment Document is enclosed.

6. Address for Correspondence - Please address all correspondence to:

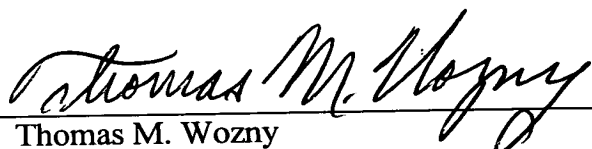
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100 East Wisconsin Avenue, St. 1100  
Milwaukee, Wisconsin 53202

Please address all telephone calls to:

Thomas M. Wozny  
(414) 271-7590

Respectfully submitted,

ANDRUS, SCEALES, STARKE & SAWALL, LLP

By   
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